

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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EJW

July 24, 2023

Cancellation No. 92075254

Zuru LLC and Zuru Inc.

v.

Lego Juris A/S

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

I. Background

Zuru LLC and Zuru, Inc., Petitioners, seek to cancel two registrations for the mark LEGO,¹ owned by Lego Juris A/S, Respondent, specifically, Registration Nos. 1018875² and 2245652,³ on the ground that each mark is generic under Trademark

¹ Both marks are described as “typeset word(s)/letter(s)/numbers(s).” Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. The mark on a typed drawing was required to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.03(i) (July 2022).

² U.S. Reg. No. 1018875, issued August 26, 1975, claiming January 1934, as its date of first use anywhere and June 4, 1953, as its date of first use in commerce for “toy building blocks and connecting links for the same, sold separately and as kits for construction of toy houses, buildings, household furnishings, robots, doll figures and vehicular toys,” in International Class 28; combined declaration under Trademark Act Sections 8 & 9, 15 U.S.C. §§ 1058 and 1059, accepted and granted on September 23, 2014; combined declaration under Trademark Act Sections 8 & 15, 15 U.S.C. §§ 1058 and 1065, accepted and acknowledged on September 9, 1981; U.S. Reg. Nos. 668633, 772738 and 905435 claimed as prior registrations.

³ U.S. Reg. No. 224562, issued May 18, 1999, claiming 1934, as its date of first use anywhere and 1953, as its date of first use in commerce for “construction toys; toy construction blocks and connecting links therefor; toy construction kits; toy figures; toy vehicles; toy animals; toy

Act Section 14(3), 15 U.S.C. § 1064(3), for the goods identified in each registration.

Respondent denies the salient allegations in the Petition for Cancellation.

This case now comes up for consideration of Petitioners' 1) fully briefed⁴ motion⁵ (filed January 4, 2023) for sanctions a) in the nature of entry of judgment or, alternatively, b) for issuance of evidentiary sanctions; and 2) an order compelling

foliage; toy cranes; toy road plates; kits for assembling toy Christmas tree decorations; children's multiple activity toys; baby multiple activity toys; toy building blocks; [infant's rattles;] dolls; doll house furnishings; accessories for dolls; playsets for dolls; playset buildings; educational games; toy model train sets; toy railroad tracks; bath toys; [ride-on toys;] push toys; pull toys; infant's stacking toys; toy furniture; toy friction motors for toy vehicles; toy electric motors; board games; [jigsaw puzzles;] educational construction toys sets comprising gears, pulleys, beams, wheels, connectors, electric motors, sensors and/or pneumatic cylinders, with or without computer software for assembling and controlling the construction toys; construction toy sets and carrying cases or storage cases sold as a unit; motorized toy model construction kits with or without remote controllers," in International Class 28; combined declaration under Trademark Act Sections 8 & 9, 15 U.S.C. §§ 1058 and 1059, accepted and granted on August 20, 2018; combined declaration under Trademark Act Sections 8 & 15, 15 U.S.C. §§ 1058 and 1065, accepted and acknowledged on March 22, 2005; U.S. Reg. Nos. "1018875, 1026871 and others" claimed as a prior registrations.

⁴ The parties' stipulations (filed May 24, 2022, 30 TTABVUE; August 18, 2022, 32 TTABVUE; and November 9, 2022, 33 TTABVUE) to extend the discovery period and reset subsequent trial dates are granted. *See* Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a). In view thereof, at the conclusion of this order, trial dates will be reset accordingly; and Petitioners' motion (filed May 4, 2022, 29 TTABVUE) to extend the discovery period is moot and will be given no further consideration. Additionally, the parties' stipulation (filed January 6, 2023, 36 TTABVUE) to extend Respondent's response due date to February 7, 2023, is granted. *See id.*

Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board's electronic docketing system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020) (citing *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014)). To allow the Board and readers to easily locate materials in the record, the parties should cite to facts or evidence in the proceeding record by referencing the TTABVUE entry and page number, e.g., "1 TTABVUE 2," and not attach previously-filed evidence to their briefs. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 801.01 and 801.03 (2023). For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation.

⁵ 35 TTABVUE.

additional discovery in view of Respondent's alleged misconduct related to its responses to Petitioners' discovery in this proceeding.⁶ Petitioners' motion is supported by the Declaration of Fatima Lahnin, and the exhibits attached thereto.⁷

The Board has considered the parties' briefs and materials or evidence submitted therewith, but addresses the record only to the extent necessary to support the Board's analysis and findings, and does not repeat or address all of the parties' arguments or materials. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings, and the arguments and materials submitted in connection with the subject motions.

The Board addresses each motion and grounds therefor sequentially.

II. Petitioners' Motion for Sanctions

A. Entry of Judgment

Petitioners move initially for the Board to enter judgment as a discovery sanction against Respondent under its "authority to enter sanctions for conduct or misconduct related to disclosures or discovery [under Trademark Rule 2.120(h)(1), which] is rooted in Fed. R. Civ. P. 37,"⁸ and pursuant to its "broad inherent authority to sanction a party for bad-faith conduct, including in discovery."⁹ As grounds therefor,

⁶ The Board notes Petitioners' unopposed Motion (filed January 26, 2023) for Leave to Supplement Record on Petitioners' Motion for Terminating Sanctions or, Alternatively, to Compel and for Evidentiary Sanctions. 37 TTABVUE.

⁷ 35 TTABVUE 29-350.

⁸ *Id.* at 14.

⁹ *Id.*

Petitioners describe Respondent’s alleged misconduct, and “fraud on the Board” and on Petitioners during discovery.¹⁰ In particular, Petitioners explain, inter alia, that at the time Respondent filed a motion to dismiss alleging, in part, that the Petition for Cancellation was filed in bad faith and is based on a frivolous claim, Respondent contemporaneously “made threats [to dictionary publishers] to induce changes to relevant evidence”¹¹ and sought to “scrub the world of evidence proving that [‘lego’ had become generic].”¹²

Further, Petitioners allege that Respondent failed to timely inform Petitioners of its letter-writing campaign, even though its existence was “directly responsive to [Petitioners’] discovery requests”¹³; and that Respondent also engaged for almost two years in evasive and obstructive behavior regarding its efforts to alter available dictionary evidence regarding the term “lego.”¹⁴ Petitioners also argue that Respondent had a duty to preserve the dictionary definitions existing prior to its letter-writing campaign because, “even if a party ... does not own or control the evidence, he still has an obligation to give the opposing party notice of access to the

¹⁰ 35 TTABVUE 2, 25 (referring to “discovery fraud”).

¹¹ *Id.* at 15.

¹² Specifically, Petitioners assert that as of January 2021, “shortly after [Petitioners] filed this Petition, ... [Respondent] embarked on a campaign to pressure 13 leading dictionary publishers to remove or revise their definitions of ‘lego.’ At the time, these dictionaries all used definitions that supported Zuru’s [sic] claim that the word ‘lego’ had become generic. ... most of the dictionaries who received [Respondent’s] letters succumbed to [its] threats and demands and revised their definitions of ‘lego’ or removed them entirely.” 35 TTABVUE 2-3, 22.

¹³ *Id.* at 3, 8 and 10. Petitioners’ discovery requests were served on April 22, 2021 and on April 29, 2022. *Id.* at 8, 10, 187 and 274.

¹⁴ *Id.* at 3, 19.

evidence or of the possible destruction of the evidence if the party anticipates litigation involving that evidence.”¹⁵ Petitioners assert that Respondent, instead, failed to preserve the pre-existing definitions of “Lego,”¹⁶ concealed its letter-writing campaign to dictionary publishers from Petitioners,¹⁷ withheld information on its efforts to change dictionary evidence from its own expert witness on lexicography and dictionaries,¹⁸ hassled Petitioners’ rebuttal expert for his lack of evidence to explain the alleged changes to the dictionary definitions of the term “lego,”¹⁹ and threatened Petitioners with Rule 11 sanctions.²⁰ Petitioners also object to Respondent halting the discovery deposition of Respondent’s Senior Corporate Counsel, Melanie Raubeson, before its completion,²¹ and Respondent’s filing in federal district court a motion for a protective order and to terminate the deposition of Ms. Raubeson.²²

1. Judgment Sanction under Trademark Rule 2.120(h)(1) Premature

To the extent Petitioners seek discovery sanctions in the nature of entry of judgment under Trademark Rule 2.120(h)(1), the motion is premature.²³ Petitioners’

¹⁵ 35 TTABVue 20 (citing *Silvestri v. Gen. Motors Corp.*, 271 F.3d 583, 590 (4th Cir. 2001) and other cases).

¹⁶ *Id.* at 20.

¹⁷ *Id.* at 19-20.

¹⁸ *Id.* at 2, 8-9.

¹⁹ *Id.* at 10.

²⁰ *Id.* at 9, 243-44; see email dated February 28, 2022 (8:27 PM) from Elizabeth (Beth) Alquist to Fatima Lahnin and others.

²¹ *Id.* at 12-13.

²² *Id.* at 13-14.

²³ As discussed further in the order, to the extent Petitioners seek relief for Respondent’s alleged spoliation of electronic dictionary evidence, Fed. R. Civ. P. 37(e) applies, which does not require the movant to confer before a motion is filed. See *Busy Beauty, Inc.*, 2019 USPQ2d

motion to compel filed on September 22, 2021²⁴ was denied for failure to demonstrate a good faith effort to resolve the parties' dispute prior to submitting the motion,²⁵ and the record shows that the Board has not issued any other discovery-related order in this proceeding. In view thereof, the prerequisite for entry of sanctions under Trademark Rule 2.120(h)(1) has not been met. *See Kairos Inst. of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (sanction of dismissal denied as premature when no Board order compelling discovery present); *cf. Nobelle.com LLC v. Qwest Commc'ns Int'l Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (trial evidence not stricken as discovery sanctions when no order to compel discovery had been violated).²⁶

Accordingly, to the extent Petitioners seek entry of judgment under Trademark Rule 2.120(h)(1), the motion for sanctions will be given no further consideration.

338392, at *2 (TTAB 2019) (“There is no requirement to make a good faith effort to resolve the parties' dispute prior to filing a motion for discovery sanctions.”).

²⁴ 19 TTABVUE.

²⁵ 28 TTABVUE 4.

²⁶ Further, even if a discovery related order had been issued against Respondent, it is well-established that entry of judgment under Trademark Rule 2.120(h)(1) is warranted in cases of repeated failure to comply with orders of the Board and where a lesser sanction would not be effective, neither of which circumstances exist here. *See, e.g., Benedict v. Super Bakery, Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011); *Revolution Jewelry Works, Inc. v. Stonebrook Jewelry, LLC*, 2022 USPQ2d 229, *7 (TTAB 2022); *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477, 1478-79 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment; sanctions in the nature of entry of judgment granted after finding that non-movant engaged for years in delaying tactics, including willful disregard of the Board's orders); *see also* TBMP § 527.01.

2. Judgment Sanction under the Board's Inherent Authority is also Premature

To the extent Petitioners request that the Board enter “termination sections” against Respondent pursuant to the Board’s inherent authority, this request is also premature. With respect to the timing of Petitioners’ motion, upon a review of the history of this proceeding, there is no previous record of alleged egregious conduct on the part of Respondent, such as filing numerous frivolous motions, willfully disregarding Board orders, failing to meet and confer with Petitioners, taxing Board resources, or fraud on the Board by actual submission of fabricated evidence. *See, e.g., SFM, LLC v. Corcamore, LLC*, 129 USPQ2d 1072, 1078-79 (TTAB 2018) (granting sanctions in the form of judgment pursuant to the Board’s inherent authority based on Respondent’s years of “particularly egregious conduct”),²⁷ *aff’d*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *see also Optimal Chem. Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *18 (TTAB 2019) (entering judgment against Petitioner, stating, “Respondent has established by clear and convincing evidence that Petitioner participated in a pattern of submitting testimony and evidence which is inaccurate, fabricated, altered, and untruthful in order to demonstrate priority of use, an integral element of its claim”).

Critically, Respondent in this case has not been repeatedly warned that its continued alleged misconduct may result in sanctions, including entry of judgment;

²⁷ In assessing sanctions under the Board’s inherent authority, the Board considers: (1) bad faith conduct; (2) willful disobedience of Board orders; (3) length of delay or clear pattern of delay; (4) due warning that sanctions may be entered; (5) reasons for non-compliance; and (6) effectiveness of lesser or alternative sanctions. *SFM v. Corcamore*, 129 USPQ2d at 1078.

nor has the Board previously issued lesser sanctions against Respondent for any misconduct, which is necessary for the Board to evaluate whether a lesser sanction would be futile. *See SFM v. Corcamore*, 129 USPQ2d at 1078 (noting that the Board concluded that a lesser sanction would be inappropriate because Corcamore had on numerous occasions already violated two sanctions orders).

Accordingly, because Petitioners' motion for sanctions in the nature of entry of judgment under the Board's inherent authority is premature, it will also not be considered.

B. Alternative Motion for Evidentiary Sanctions²⁸

In the alternative to entry of judgment against Respondent, Petitioners request that the Board issue sanctions in the nature of making certain evidentiary presumptions against Respondent (discussed *infra*) and striking any expert opinion offered by Respondent's expert witness, Edward Finegan, Ph.D.²⁹

The Board construes Petitioners' alternative motion as one seeking sanctions in the nature of making adverse inferences and issuing an exclusion order. As grounds for such sanctions, Petitioners allege primarily that Respondent engaged in spoliation

²⁸ Petitioners' allegations that Respondent violated 37 C.F.R. § 11.804 and Connecticut Rule of Professional Conduct 3.4(1), 35 TTABVUE 19, are not properly submitted to the Board. *See* 37 C.F.R. §§ 2.193, 11.18(d), 11.20, 11.804 and 11.19-11.60; *see generally* TBMP §§ 115.02 and 527.02. Accordingly, to the extent Petitioners seek sanctions for Respondent's alleged misconduct under various ethics rules, the motion is **DENIED**.

²⁹ 35 TTABVUE 4, 26.

of evidence,³⁰ and engaged in discovery fraud by hiding the dictionary letters from Petitioners and Respondent's own expert witness.³¹

1. Motion for Evidentiary Sanctions - Adverse Inferences

A motion for sanctions under the Board's inherent authority "is used when applicable statutes or rules do not appear to cover a particular instance of bad conduct." *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1906-07 (TTAB 2008) (citing *Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1214 (TTAB 2001)); *see also SFM v. Corcamore*, 129 USPQ2d at 1075 ("When misconduct does not squarely fall within the reach of Fed. R. Civ. P. 11, Fed. R. Civ. P. 37(b)(2) or Trademark Rule 2.120(h), the Board may invoke its inherent authority to enter sanctions.").

Here, because Petitioners' motion to compel was denied as premature,³² and there exists no other order based on which the Board could issue sanctions under Trademark Rule 2.120(h)(1), 37 C.F.R. § 2.120(h)(1), the Board shall consider Petitioners' motion under its inherent authority. *See, e.g., Optimal Chem.*, 2019

³⁰ Evidentiary issues such as spoliation are often addressed at trial. *See, e.g., Optima Chem.* at *4. Consideration of Petitioners' motion for sanctions does not alter the Board's longstanding policy against addressing substantive evidentiary objections prior to final hearing. *Kate Spade LLC v. Thatch*, 126 USPQ2d 1098, 1101 (TTAB 2018) (citing *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003); *M-Tek Inc. v. CVP Sys. Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990)). Insofar as the subject motion essentially involves a discovery dispute and the nature of one party's conduct, it is appropriate to consider Petitioners' concerns even though they involve evidence that may be adduced at trial. *See, e.g., Busy Beauty*, 2019 USPQ2d 338292, at *1 (considering motion for adverse inference under Fed. R. Civ. P. 37(e) before close of discovery).

³¹ 35 TTABVUE 4.

³² 28 TTABVUE 4.

USPQ2d at *8 (“If a party is found to have manufactured evidence by fabrication or alteration of preexisting evidence, or to have intentionally provided false testimony in a deposition or at trial, dismissal of that party’s claims or defenses can be the proper sanction as an exercise of the Board’s inherent authority to protect the integrity of the judicial process.”).

(a) Spoliation

(i) Respondent’s Conduct vis-à-vis Third Parties is not Improper

The basic premise underlying Petitioners’ motion for sanctions is their objection to Respondent’s “shocking” and “secret efforts to alter the public record,”³³ which allegedly commenced shortly after the commencement of the proceeding,³⁴ asserting, in part, that Respondent’s actions vis-à-vis dictionary publishers cannot be viewed as “routine ‘policing’” of the involved marks.³⁵ Rather, Petitioners argue that Respondent sought to “tamper with relevant evidence to impact the outcome of this proceeding,³⁶ [and ... that] [Respondent’s] bad-faith conduct [] resulted in evidence

³³ 35 TTABVUE 2-3.

³⁴ *See also, id.* at 4:

The Board should not condone such extraordinary misconduct. The dictionary evidence that TLG altered and sought to eliminate offers strong support for Zuru’s position that the word “lego” has become generic. The Board need look no further than TLG’s own attempts to alter that evidence, and its explicit statements to the dictionaries, to know that is true. TLG tried to change the public record because it was unfavorable to its position in this case.

³⁵ 35 TTABVUE 16.

³⁶ *Id.*

spoliation because [Respondent] did not preserve the dictionary definitions in their original form, before it induced changes through its threats.”³⁷

Petitioners’ contentions conflate Respondent’s legitimate actions to protect its Lego marks with the apparent effects of its policing activities, i.e., altered on-line dictionary definitions of the term “Lego.” For the reasons discussed below, Petitioners’ attempt to characterize Respondent’s letter-writing campaign and its alleged failure to preserve the dictionary definitions existing prior to the filing of the Petition for Cancellation, as spoliation, distinct from “routine policing,” is erroneous.

Petitioners’ evidence shows that shortly after the Petition for Cancellation was filed, Respondent sent letters to 13 publishers of on-line dictionaries by which it sought to change their respective on-line definitions of the term “Lego.”³⁸ For the following reasons, the Board finds that Respondent’s letter-writing effort requesting publishers to change their respective “Lego” definitions does not constitute litigation misconduct, much less spoliation, regardless of the timing of Respondent’s actions.

As a general matter, a trademark owner is not only entitled to police others’ use of its registered mark, but its failure to prevent widespread improper, generic use of its mark may subject the trademark owner to a determination that it has abandoned

³⁷ 35 TTABVue 18-19.

³⁸ *Id.* at 98-123; *see also id.* at 125-163 (email exchanges between counsel for Lego and publishers or their respective representatives).

its mark.³⁹ Should a trademark owner fail to police its mark, the owner risks its mark losing its ability to identify and distinguish a single source and becoming the generic name for the goods or services in connection with which the mark is used. *See, e.g., BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1555-57 (Fed. Cir. 1995) (affirming Board decision that “Walking Fingers” logo is generic for classified telephone directories, noting that “AT&T allowed any and all competing publishers of telephone directories [and Independent (*i.e.*, non-Bell) telephone companies and directory publishers] to use the logo on their own [telephone] directories ... [such that] the logo ... now identifies the product—classified telephone directories—generally.”); *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 84 USPQ2d 1530, 1535 (9th Cir. 2007) (“trademark owners are free (and perhaps wise) to take action to prevent their marks from becoming generic and entering the public domain—e.g., through a public relations campaign or active policing of the mark’s use”); *Ill. High School Ass’n v. GTE Vantage Inc.*, 99 F.3d 244, 40 USPQ2d 1633, 1635 (7th Cir. 1996), as amended (Dec. 3, 1996) (“A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or

³⁹ *See* Trademark Act Section 45, 15 U.S.C. § 1127:

A mark shall be deemed to be “abandoned” ...:

- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.

service.”); J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:29 (5th ed. June 2023 update) (a trademark owner’s failure to police infringements of its mark, so that widespread usage by competitors leads to generic name usage among the relevant public may result in “genericide”).⁴⁰

Moreover, Petitioners’ request for sanctions based on Respondent’s specific efforts to effect changes to various dictionaries is unsupported by Board precedent. In particular, in determining the nature of the involved mark, the Board has previously recognized the probative value of a trademark owner’s letter to the editor of a newspaper that used its mark in a generic sense, finding that such effort was relevant evidence of trademark status, especially since the newspaper printed a correction notice. *See Plyboo Am. Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1641-42 (TTAB 1999) (Board determined that PLYBOO was not merely descriptive of, “let alone generic,” for the relevant goods, noting that “only a distinct minority of the articles either show the term ‘plyboo’ used in a merely descriptive fashion as the generic name for the parties’ goods ... and one of those articles was in fact subsequently ‘corrected,’ at opposer’s insistence, to indicate that the term ‘PLYBOO is a trademark ... and is not a generic term for bamboo flooring”); *see also Zimmerman v. Nat’l Ass’n of Realtors*, 70 USPQ2d 1425, 1434 (TTAB 2004) (denying petition to cancel on the ground of genericness, stating in relevant part, “[t]he evidence establishes aggressive marketing of these marks and constant policing of media usage of these terms, supporting respondent’s position that it has preserved for the term no small degree

⁴⁰ *See also* MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, *id.* at §§ 12:28 and 17:8.

of proprietary meaning, even among general news outlets.”); *cf. In re Empire Tech Dev. LLC*, 123 USPQ2d 1544, 1565-66 (TTAB 2017) (applicant’s “failure to police these generic uses of its proposed mark undercuts its claim that the relevant purchasing public will understand COFFEE FLOUR to be anything other than the generic term for flour made from coffee cherries”); *In re Trek 2000 Int’l*, 97 USPQ2d 1106, 1112 (TTAB 2010) (one factor in determining whether applied-for mark was generic was applicant’s record of policing its asserted trademark, namely, “letters to and responses from various media outlets, including ‘PC Magazine’ and ‘The New York Times,’ whereby they agreed not to use THUMBDRIVE in a generic manner”).

In view of the foregoing, insofar as the Board has previously recognized the significance of trademark owners’ policing efforts in determining whether a particular trademark is or has become generic for the relevant goods or services, the Board is not persuaded that Respondent’s letter-writing campaign to dictionary publishers at the outset of this proceeding constitutes improper conduct for which sanctions in the should be issued.

(ii) Respondent’s Conduct does not Constitute Spoliation

Petitioners concomitantly assert that Respondent’s (i) efforts to alter dictionary definitions of “Lego,” along with its (ii) ancillary failure to preserve copies of the dictionaries’ previous definitions of “Lego,” amount to spoliation of evidence.⁴¹ For the following reasons, Petitioners’ arguments are unavailing.

⁴¹ 35 TTABVUE 19.

“Spoliation refers to ‘the destruction or material alteration of evidence or the failure to preserve property for another’s use as evidence in pending or reasonably foreseeable litigation.’” *Rapid Inc. v. Hungry Marketplace, Inc.*, 2022 USPQ2d 678, *52 (TTAB 2022) (party altered evidence by demanding that the third party delete first use date on a press release); *Optimal Chem.*, 2019 USPQ2d 338409, at *16 (finding spoliation when screenshots capturing product images were annotated by party to include false dates) (internal citation omitted) (citing *Silvestri v. Gen. Motors Corp.*, 271 F.3d 583, 590 (4th Cir. 2001)).⁴²

However, “a party can only be sanctioned for destroying evidence if it had a duty to preserve it.” *See Micron Tech., Inc. v. Rambus Inc.*, 645 F.3d 1311, 1320 (Fed. Cir. 2011) (quoting *Zubulake v. UBS Warburg LLC*, 220 F.R.D. 212, 216 (S.D.N.Y. 2003)); *see also Trigon Ins. Co. v. U.S.*, 204 F.R.D. 277, 286 (E.D. Va. 2001) (“To establish spoliation the moving party must show that the adverse party had a duty to preserve

⁴² Some courts have stated, “[t]he spoliation of evidence rule ... [applies] not just [to] the destruction of evidence, ... but also against one who fails ... to produce evidence—including the testimony of witnesses.” *Hodge v. Wal-Mart Stores, Inc.*, 360 F.3d 446, 450 (4th Cir. 2004) (citing *Vodusek v. Bayliner Marine Corp.*, 71 F.3d 148, 155-56 (4th Cir. 1995) (noting that failure to produce a witness “that naturally would have elucidated a fact at issue” may justify an adverse inference)). In this case, the Board declines to broaden the definition of spoliation to include a party’s “failure to produce evidence,” insofar as a party’s failure to timely disclose or supplement or, e.g., to allow a witness to appear at a deposition, may be addressed adequately by application of the Trademark Rules of Practice related to discovery and the Board’s numerous precedential cases involving application of relevant Federal Rules of Civil Procedure and determining whether the failure to disclose is substantially justified or harmless. *See, e.g., Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011); *see also Gemological Inst. of Am., Inc. v. Gemology Headquarters Int’l, LLC*, 111 USPQ2d 1559, 1561-62 (TTAB 2014); *Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009) (citing to Fed. R. Civ. P. 26(e) and 37(c)(1), documents not produced until after the start of trial ordered stricken); *Quality Candy Shoppes/buddy Squirrel of Wis.*, 90 USPQ2d at 1392 (“A party is required to respond completely to discovery to the best of its ability and to supplement discovery responses as soon as it becomes aware of new information.”).

the allegedly spoiled documents and that the documents were intentionally destroyed.”).

A duty to preserve evidence arises when a party knows or reasonably should know that evidence in its possession, custody or control, or to which that party has access, may be relevant to a reasonably foreseeable legal action. *See, e.g., Silvestri*, 271 F.3d at 591 (explaining how the duty to preserve applies to evidence to which the party merely has access, even if it does not own or have physical possession); *Victor Stanley, Inc. v. Creative Pipe, Inc.*, 269 F.R.D. 497, 520-21 (D.Md. 2010) (“In the Fourth Circuit, to prove spoliation that warrants a sanction, a party must show: ‘(1) [T]he party having control over the evidence had an obligation to preserve it when it was destroyed or altered; ...’”) (reviewing law applied in other federal circuit courts).

Additionally, even though the evidence involved in this matter involves electronically-stored information (“ESI”),⁴³ the requirement that a party have possession, custody, control, or access to the evidence in order to give rise to a duty to preserve also applies. “A party’s fail[ure] to take reasonable steps to preserve the [ESI],” required under Fed. R. Civ. P. 37(e), logically presumes that the party alleged to have failed to preserve the ESI must have had the duty to do so in the first instance, such duty having been created by the ability to preserve the ESI, i.e., from possession, custody, control, or access to particular evidence. *See, e.g., Optimal Chem.*, 2019

⁴³ 35 TTABVUE 7, 98-123. In *Optimal Chem.*, the Board noted that the four-part test for spoliation discussed in *Silvestri* and in *Micron Tech.* applied to the destruction of both tangible and electronic evidence until December 1, 2015, at which time Fed. R. Civ. P. 37 was amended to provide a different standard for destruction of electronically stored information. *Optimal Chem.*, 2019 USPQ2d 338409, at *5.

USPQ2d 338409, *5 (“there is no doubt that Petitioner had control over [the webpage] and had an obligation to preserve it”); *Busy Beauty*, 2019 USPQ2d 338392, *4 (“If the duty to preserve has been triggered, a party has failed to take reasonable steps to preserve, and information has been lost as a result, the inquiry focuses on the fourth factor ...”); *see also Steves & Sons, Inc. v. JELD-WEN, Inc.*, 327 F.R.D. 96, 104 (E.D.Va. 2018) (explaining that “Rule 37(e) does not apply to **every** situation where spoliation occurs ... [f]or a court to impose a sanction under its inherent power, the party seeking sanctions for spoliation, or the destruction of evidence, must show: (1) the party having control over the evidence had an obligation to preserve it at the time it was destroyed or altered; ...”) (internal quotations deleted) (emphasis original).

This matter differs from previous Board cases that address spoliation insofar as the entities who altered the dictionary evidence here are third parties, i.e., various dictionary publishers. Therefore, with respect to Petitioners’ contention that Respondent spoliated the dictionary definitions existent prior to its letter-writing campaign and failed to preserve those definitions, the issue here is whether Respondent had a duty to preserve that evidence. In other words, as a threshold matter, to sanction a party for destroying or altering evidence held and altered by a third party, the party alleging spoliation must show that its adverse party had a duty, i.e., the ability, to preserve or alter the evidence.

The prerequisite that a party have a duty to preserve the evidence for sanctions for spoliation to issue, when a third party destroyed or altered the evidence, is demonstrated in the Board’s decision in *Rapid Inc. v. Hungry Marketplace, Inc.*, 2022

USPQ2d 678 (TTAB 2022). In *Rapid*, the Board determined that the opposer's principal had been dishonest with the Board during trial and had effectively spoliated evidence by, inter alia, contacting a third party, the Internet Archive ("the Wayback Machine") and requesting that it remove the captures showing the original date of the online press release at issue. 2022 USPQ2d 678, at *38-41 and *52.⁴⁴

Notably, the Internet Archive required the opposer to verify that the person requesting removal was "the site owner or author" of the content. *Id.* at *40. Although not specifically discussed in *Rapid*, it is clear that a particular relationship existed between the opposer and the Internet Archive, akin to a bailor/bailee or similar contractual arrangement, which enabled the opposer to request and effect changes to the archived press release. *See In re WRT Energy Securities Litig.*, 246 F.R.D 185, 195 (S.D.N.Y. 2007) (noting that [another] court held that, for purposes of spoliation, "control need not entail actual custody of the evidence if, in fact, such evidence is in the hands of a bailee subject to instruction from the bailor.") (internal citations omitted). Essentially, because the opposer in *Rapid* had sufficient authority in regard to the archived material to demand the alteration of the press release, the Board held opposer responsible for the spoliation, even though the third party actually altered the press release. The Board noted specifically, "approximately two weeks after filing the notice of opposition in this case, Opposer tried to scrub the existence of the

⁴⁴ Specifically, the Board held that opposer's pattern of fabrication and spoliation of evidence "vitiates the probative effects of [opposer's] testimony and evidence, and taints the remainder of evidence that might otherwise indirectly support opposer's claim of priority." 2022 USPQ2d 678, at *54 (dismissing opposer's likelihood of confusion claim because opposer has not met its burden of proving priority).

original article from the web by contacting the Internet Archive, and was successful.”
2022 USPQ2d 678, at *53.

Here, Respondent had no duty to preserve the dictionary definitions of “Lego” existent prior to the filing of the Petition for Cancellation. In contrast to *Rapid*, Petitioners have not demonstrated, much less argued, that any sort of agency, bailor/bailee, or other contractual arrangement exists between Respondent and the 13 dictionary publishers such that Respondent could have **required** the publishers to change the dictionary definitions of “Lego,” or demanded that the dictionary publishers retain records of past definitions of “Lego” set forth in their publications; and the Board finds no such evidence in the record. *See Rodda v. Joy Mining Mach.*, 15 F.Supp.3d 1156, 1160 n.7 (N.D.Ala. 2014) (“Sanctions may be imposed against a litigant based on a third party’s spoliation of evidence if the third party acted as the litigant’s agent in destroying or failing to preserve the evidence.”) (internal citation omitted); *Goodman v. Praxair Servs., Inc.*, 632 F.Supp.2d 494, 523 n.16 (D.Md. 2009) (“A party may be held responsible for the spoliation of relevant evidence done by its agents.”); *Townsend v. Am. Insulated Panel Co., Inc.*, 174 F.R.D. 1, *4-5 (D.Mass. 1997) (noting that the third parties involved were not agents of the plaintiff, “the duty [to preserve] does not extend to evidence which is not in the litigant’s possession or custody and over which the litigant has no control”); *cf.* Fed. R. Civ. P. 34(a).⁴⁵

⁴⁵ Under Fed. R. Civ. P. 34, “control’ does not require that the party have legal ownership or actual physical possession of the documents at issue; rather, documents are considered to be under a party’s control when that party has the right, authority, or practical ability to obtain the documents from a non-party to the action.” *In re NTL, Inc. Sec. Litig.*, 244 F.R.D. 179, 195 (S.D.N.Y. 2007), *aff’d sub nom.*, *Gordon Partners v. Blumenthal*, No. 02 CIV 7377 LAK,

On the contrary, the fact that the Oxford University Press (regarding www.oxfordlearnersdictionaries.com and www.lexico.com) declined to change how “Lego” is presented in those online dictionaries⁴⁶ shows that Respondent lacks either control over or access to the dictionary definitions of “Lego,” much less possession or custody, and has no control over the conduct of the dictionary publishers.

Accordingly, in view of a trademark owner’s right to police its mark to prevent it from becoming a generic term for the goods and services with which they are sold, discussed supra, and the requirement that a party must have possession, custody, control, or access to particular evidence, or otherwise be able to affect the evidence at issue (e.g., through agency or contract with a third party), in order to create a duty to preserve that evidence, the Board finds that Respondent’s efforts to change dictionary definitions of “Lego” and its alleged failure to preserve the dictionaries’ previous definitions of “Lego,” do not constitute spoliation of evidence, as Petitioners allege. Simply put, Respondent had no duty to preserve the dictionary entries.⁴⁷ *See, e.g., GenOn Mid-Atlantic, LLC v. Stone & Webster, Inc.*, 282 F.R.D. 346, 355 (S.D.N.Y. 2012) (“it is sufficient for [movant] to establish that [the adverse party] had *either* the legal right or the practical ability to obtain [the third party’s] materials”) (emphasis original); *Goodman v. Praxair Servs., Inc.*, 632 F.Supp.2d at 514-15 (analogizing to

2007 WL 1518632 (S.D.N.Y. May 17, 2007) (citing *Bank of New York v. Meridien BIAO Bank Tanzania Ltd.*, 171 F.R.D. 135, 146-47 (S.D.N.Y.1997)).

⁴⁶ 35 TTABVUE 125-26.

⁴⁷ The Board is also perplexed as to why Petitioners did not retain their own copies of evidence which, presumably, were part of the basis for filing the Petition for Cancellation in the first place. *See* Petition ¶ 20(d), 1 TTABVUE 6.

Fed. R. Civ. P. 34(a), the duty to preserve “would not require a party to have legal ownership or actual physical possession of any documents at issue. ... Instead, documents are considered to be under a party’s control when that party has ‘the right, authority, or practical ability to obtain the documents from a non-party to the action’”; defendant employer not held liable for spoliation by third-party consultants because the defendant had neither legal control over the third-party’s documents, nor the practical ability to cause them to preserve those documents) (citing to *In re NTL, Inc. Securities Litig.*, 244 F.R.D. 179, 195 (S.D.N.Y. 2007)).

Accordingly, to the extent Petitioners seek evidentiary sanctions in the nature of adverse inferences on the ground that Respondent engaged in spoliation of evidence, Petitioners’ motion for sanctions is **DENIED**.

(b) “Discovery Fraud”

(i) Adverse Inferences

Petitioners argue that the Board should sanction Respondent for discovery fraud by making four adverse inferences against Respondent, namely, the Board should:

- “find that all 13 dictionary definitions [that Respondent] challenged provide evidence of the genericism of the ‘lego’ mark;”
- make “an inference that ‘dictionary evidence’ in general is unfavorable to [Respondent],”
- make an inference that the dictionary evidence supports a finding of genericism, and

- enter “a presumption that ‘lego’ has become generic.”⁴⁸

As grounds for drawing such inferences, Petitioners contend that Respondent committed discovery fraud by the following misconduct:

- failing to timely disclose and supplement its discovery production with the 13 letters to the dictionary publishers and related emails,
- hiding its letter-writing efforts from its own expert and from Petitioners’ rebuttal expert, and
- misleading Petitioners that it had already produced all documents relating to Respondent’s efforts to prevent generic use of “Lego.”⁴⁹

Respondent argues that Petitioners’ allegations of discovery fraud and counsel misconduct constitute a diversionary tactic prompted by the weakness of their genericness claim, “in a transparent attempt to side-step the merits of this proceeding.”⁵⁰ Respondent also asserts that because discovery is still open as of the filing date of Petitioners’ motion,⁵¹ Petitioners have suffered no harm due to the delay in supplementing its discovery production.⁵² The Board is not persuaded by Respondent’s characterization of Petitioners’ concerns. Rather, “it seems ... absolutely necessary to consider a serious fraud allegation of a party as being of

⁴⁸ 35 TTABVUE 26.

⁴⁹ 35 TTABVUE 3.

⁵⁰ 38 TTABVUE 2.

⁵¹ *See supra* footnote 4, granting the parties’ stipulation (filed November 9, 2022) to extend fact discovery until February 28, 2023) and subsequent trial dates. 33 TTABVUE 3.

⁵² 38 TTABVUE 18.

significance in view of the great importance of the integrity of the conduct of trademark conflict proceedings in this Office.” *Doctor Vinyl & Assoc. v. Repair-It Indus., Inc.*, 220 USPQ 639, 646-47 (TTAB 1983); *see also Optimal Chem.*, 2019 USPQ2d 338409, at *8 (citing *Aoude v. Mobil Oil Corp.*, 892 F.2d 1115, 1118-19 (1st Cir. 1989) (fraud on the court occurs where “a party has sentiently set in motion some unconscionable scheme calculated to interfere with the judicial system’s ability impartially to adjudicate a matter by ... unfairly hampering the presentation of the opposing party’s claim or defense.”)).

(ii) Legal Standard

Adverse inferences may be drawn properly from insufficient responses to discovery requests. “A party is required to respond completely to discovery to the best of its ability and to supplement discovery responses as soon as it becomes aware of new information. Fed. R. Civ. P. 26(e).” *Quality Candy Shoppes/Buddy Squirrel of Wis., Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007). As the Board has emphasized, “Each party and its attorney has a duty to make a good faith effort to satisfy the discovery needs of its adversary. ... The parties are also reminded of their ongoing duty to supplement their discovery responses in a timely manner. Fed. R. Civ. P. 26(e)(1)(A).” *Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663 *12 (TTAB 2019). When a party fails to do so, on a critical issue central to the case, an adverse inference may properly be drawn. *See, e.g., Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983) (no error in drawing an adverse inference where witnesses

inappropriately refused to answer relevant questions), *aff'g*, 213 USPQ 594 (TTAB 1982); *see also Stawski v. Lawson*, 129 USPQ2d 1036, 1046 (TTAB 2018) (“When it is within a party’s power to produce a certain kind of persuasive testimony or documentary evidence on an urged factual finding, and it fails to do so, a tribunal is at least permitted--perhaps even compelled--to draw the inference that that fact is unsupported and/or untrue.”) (quoting *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1794 (TTAB 2017)), *appeal dismissed*, No. 19-1617 (Fed. Cir. Dec. 19, 2019)); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer’s objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer’s position); *cf. Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (“[I]n the event the Board finds that refusal to answer a question [during a testimony deposition] was not justified, the Board will presume that the answer to the question would have been adverse to the position of the party whose witness refused to answer.”).

However, as a general rule, the Board will not draw adverse inferences against a party based on evasive or insufficient responses to the adverse party’s discovery requests in the absence of a motion to compel or a motion challenging the sufficiency of responses to requests for admission. *See, e.g., H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1719 (TTAB 2008) (party that receives response it believes inadequate but fails to file a motion to test sufficiency of response, may not thereafter complain about its insufficiency); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (These objections were not of a nature which would have led petitioner to believe that

no such documents existed ... and because there is no indication in the record that petitioner moved to compel answers to either the interrogatory or the production request, petitioner cannot now be heard to complain that the documents were not identified and produced.”); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (no adverse inference based on inconsistent responses without motion to compel).

Here, Petitioners have not filed a motion to compel. Nonetheless, insofar as Petitioners’ alternative motion for sanctions in the nature of adverse inferences is based on various misconduct allegedly committed by Respondent, including hiding information from Respondent’s own expert witness and misleading Petitioners as to whether any responsive documents exist related to generic use of the “Lego” marks, the Board will consider, in this instance, certain of Petitioners’ Requests for Production of Documents that are most relevant to Respondent’s alleged misconduct.

(iii) Factual Findings

Given the complex facts and number of exhibits submitted by both parties in connection with the subject motion, the Board finds it appropriate to review a summary of the salient facts that pertain to this segment of the subject motion, as follows:

1. The Petition for Cancellation was filed on September 1, 2020.⁵³ On January 25, 2021, Respondent’s in-house counsel, Ms. Raubeson, sent letters to 13 dictionary publishers requesting that each of them make certain changes to their definitions of “the LEGO mark.”⁵⁴

⁵³ 1 TTABVUE.

⁵⁴ 35 TTABVUE 99-123.

2. On April 22, 2021,⁵⁵ Petitioners served their First Set of Requests for Production of Documents. Request Nos. 4 and 11, which included, in part, the requests shown below.

Request No. 4: All Documents evidencing or concerning any alleged misuse and/or improper use of the Challenged Marks, and/or the terms “LEGO”, “Lego”, “lego” or “legos.”⁵⁶

Request No. 11: All Documents regarding your efforts and/or plans to prevent the generic use of the Challenged Marks and/or the possibility that the Challenged Marks may have become generic.⁵⁷

3. Notably, in each of Respondent’s 13 dictionary letters, Respondent stated, “the Company does not allow third parties to use or define the LEGO trademark as a generic term,” and specifically sought, “revised definitions that make[] clear that [LEGO] is a trademark, to alleviate our concerns regarding misuse of the LEGO mark.”⁵⁸
4. Respondent objected, in part, to Request Nos. 4 and 11, by stating, “[t]here are no claims or allegations [in the Petition for Cancellation] concerning Respondent’s failure to police or enforce the Challenged Marks, or that a failure to police or enforce caused the Challenged Marks to be generic.”⁵⁹
5. Respondent interpreted Request No. 4, “to call for documents related to use of the Challenged Marks as generic terms and not as source identifiers” and, therefore, Respondent responded that it was is not aware of any non-privileged documents in its possession, custody or control responsive to this request.⁶⁰ In addition to its objections, Respondent responded initially to Requests Nos. 4 and 11 by stating that, “Respondent is not aware of any non-privileged documents in its possession, custody or control responsive to this Request.”⁶¹

⁵⁵ 35 TTABVUE 8, 187.

⁵⁶ *Id.* at 182.

⁵⁷ 35 TTABVUE 183.

⁵⁸ *Id.* at 97-123.

⁵⁹ *Id.* at 195, 198. Respondent also objected to these Requests as being overly broad and unduly burdensome, and not proportional to the needs of this proceeding because they purport to “require Respondent to identify each and every instance of improper use of the Challenged Marks over a more than [a] forty-five year period of time.” *Id.*

⁶⁰ 38 TTABVUE 17.

⁶¹ 35 TTABVUE 196, 199.

6. Ms. Raubeson stated in a later exchange with Petitioners' counsel that Respondent did not view its letters to dictionary publishers to be "cease and desist letters."⁶²
7. Petitioners' counsel emailed Respondent's counsel on July 19, 2021 (8:01 PM), objecting, inter alia, to Respondent's objection "to almost every request on the basis that the discovery sought 'is not limited by subject matter (e.g. improper use or misuse of the Challenged Marks as a non-source identifier).'"⁶³
8. In an email dated July 28, 2021 (11:51:54 PM) responding to the July 19, 2021 email from Petitioners' counsel, Respondent's counsel stated, "we are not withholding any responsive information or documents based on this objection."⁶⁴ In the same letter, Respondent's counsel wrote, "the only potentially relevant e-mails are external e-mails that the company has with third-parties that concern the use or perception of the Challenged Marks, however, the same challenges regarding devising reasonable non-burdensome means of searching for, identifying, and collecting such e-mails remain."⁶⁵ In the same email, counsel for Respondent stated that it was undertaking a reasonable search for additional cease and desist letters concerning the Challenged Marks that have not already been produced, and intends to produce a representative sample of other documents sufficient to show the company's enforcement and policing efforts from 2016 to present ..."⁶⁶
9. On August 5, 2021 (9:57 PM), in an email to Respondent's counsel, Petitioners argued, inter alia, that evidence such as third party use of the challenged marks is relevant and admissible, and even if Respondent disputes the evidentiary value of the information requested, the information is still discoverable.⁶⁷ In Respondent's counsel's emailed response on August 6, 2021 (4:23 PM), relative to this segment of Petitioners' counsel's email, Respondent's counsel stated, "there are other categories for which the company has already started collecting and

⁶² 38 TTABVUE 13, 601; Raubeson dep, 31:10-15 ("Q: Are your letters to the dictionaries cease and desist letters? A: No. Q: Why not? A: I'm not asking them to cease nor desist anything.").

⁶³ 35 TTABVUE 210.

⁶⁴ *Id.* at 205.

⁶⁵ 35 TTABVUE 205.

⁶⁶ *Id.* at 206.

⁶⁷ 19 TTABVUE 100.

reviewing documents, and will make those documents available for production within a reasonable time.”⁶⁸

10. On September 2, 2021 (9:28 PM),⁶⁹ in an email to Petitioners’ counsel, Respondent stated as follows:

With respect to the first category (i.e. “(1) those employees in charge of policing the Challenged Marks”), despite extensive efforts, we have not been able to identify anyone outside of the legal department who fits this category. Our investigation confirmed that the employees responsible for policing the Challenged Marks are attorneys in the legal department and, based on our interviews, the documents and communications generated as result of these efforts qualify as privileged attorney-client communications and/or attorney work-product. It would be incredibly burdensome to collect, review and prepare a privilege log for all of the e-mails for the approximately 20 attorneys, paralegals and legal professionals in the legal department that we have identified as potentially having some involvement in policing and enforcing the Challenged Marks in the United States from January 1, 2015 to present. This burden is not proportional to the needs of the case especially because our client has already agreed to produce cease and desist letters, oppositions, complaints, and administrative petitions or arbitration demands, and any related non-privileged correspondence, sufficient to show the actions that our client took to police the Challenged Marks from January 1, 2015 to present, and, as part of this effort, we are manually collecting any cease and desist letters or e-mails that in-house counsel sent concerning infringement, misuse or improper use of Challenged Marks. Our client is not willing to designate any members of the legal team as custodians.

11. Respondent threatened Petitioners with sanctions for pursuing their genericism case in bad faith, including based on the purported lack of evidence to support their claim.⁷⁰
12. The proceeding was suspended on October 5, 2021, in view of Petitioners’ motion to compel.⁷¹ By the motion to compel, Petitioners sought, inter alia, production of “information concerning Respondent’s policies and practices

⁶⁸ 19 TTABVUE 103.

⁶⁹ 35 TTABVUE 215, 218 and 219; *see also* 19 TTABVUE 118.

⁷⁰ 35 TTABVUE 243-244.

⁷¹ 20 TTABVUE.

to monitor, track and/or police the use or improper use of the lego word mark.”⁷² Petitioners’ motion to compel did not address Petitioners’ Requests for Documents Nos. 4 or 11.

13. Dr. Finegan’s September 20, 2021 Expert Report states, in relevant part, “Dictionaries Demonstrate LEGO is Not a Generic Term”⁷³ and explains also that there are two categories (“buckets”⁷⁴) of dictionaries, i.e., those without definitions of “Lego” (e.g., *Merriam-Webster Unabridged Dictionary*, *The American Heritage Dictionary* and Macmillan), and another category, which shows “Lego” (capitalized) and a clear identification as a trademark.⁷⁵ The report specifically discusses *The Cambridge Dictionary*, stating that it defines “LEGO” in U.S. usage as a “brand name,”⁷⁶ and contrasts his search results with Petitioners’ conflicting allegation regarding *The Cambridge Dictionary* in the Petition for Cancellation.⁷⁷
14. During Dr. Finegan’s first deposition on March 2, 2022, in response to the questions of Petitioners’ counsel, Dr. Finegan noted a difference in the definitions of “Lego” in *The Cambridge Dictionary* between pages 46 and 73 of his report, and he responded that he did not know what happened,⁷⁸ but speculated that one possible explanation was that the Cambridge Dictionary lexicographers received a letter, “a warning or something from LEGO Group.”⁷⁹
15. A representative of Respondent’s outside counsel, Day Pitney LLP, i.e., elivingstone@daypitney.com, was blind copied on the 13 emailed dictionary letters sent by Respondent’s outside counsel, Ms. Raubeson.⁸⁰

⁷² 19 TTABVUE 3.

⁷³ 35 TTABVUE 238.

⁷⁴ *Id.* at 326, 146:5 (9/20/2021, first Finegan deposition).

⁷⁵ 35 TTABVUE 238-40 (¶¶ 22-29) (Expert Report).

⁷⁶ *Id.* at 240 (¶ 28).

⁷⁷ *Id.* at 239-240 (¶¶ 26-28).

⁷⁸ *Id.* at 224-227, 135:9-138:5 and 138:19-139:20; compare “Lego” definitions at 35 TTABVUE 252 (“a brand name for a type of small plastic brick or other piece that children can join with others to make models of many different objects”), relied on by Dr. Finegan, with 35 TTABVUE 33, 246 (original “U.S.” definition: “a small plastic brick or other piece that children can join with others to make models of many different objects,” noun-trademark) relied on by Petitioners.

⁷⁹ 35 TTABVUE 228-29, 140:4-141:2.

⁸⁰ 37 TTABVUE 7, 10, 13, 16, 19, 22, 25, 28, 31, 34, 37, 40, and 43.

16. Although both Respondent's in-house counsel, Ms. Raubeson, who wrote the 13 dictionary letters, and a representative of Day Pitney were present during Dr. Finegan's first deposition,⁸¹ there is no indication in the parties' submissions that after Dr. Finegan's deposition, Ms. Raubeson or Respondent's outside counsel communicated with Petitioners' counsel regarding "what happened," i.e., to explain why the definition of "Lego" had changed in *The Cambridge Dictionary*.⁸²
17. On March 16, 2022, Respondent deposed Petitioners' rebuttal expert, Robert Leonard, Ph.D.⁸³ Although Respondent's outside and in-house counsel knew that neither Petitioners nor Dr. Leonard knew about the dictionary letters, Respondent's counsel challenged Dr. Leonard, asserting that he had no direct evidence that the LEGO Group "put pressure on a dictionary."⁸⁴
18. On April 12, 2022, the Board denied Petitioners' motion to compel for failure to show a good faith effort to resolve the parties' dispute prior to filing the motion and the proceeding resumed.⁸⁵
19. Petitioners served a second set of document requests on April 29, 2022, which included the very specific Request Nos. 45 and 47, which requested the following:
- Request No. 45: All documents in the Respondent's possession or control concerning use of the term "lego" or "legos" in *The Cambridge Dictionary*.⁸⁶
- Request No. 47: All documents in the Respondent's possession or control concerning the Respondent's response to and/or effort to change, alter or in any way modify the definition of the term "lego" or "legos" in any dictionary or glossary.⁸⁷
20. In response to Request Nos. 45 and 47, subject to Respondent's objections, Respondent stated as follows:

⁸¹ 35 TTABVUE 222, 3:13-21.

⁸² *Id.* at 10.

⁸³ 35 TTABVUE 258-61.

⁸⁴ 35 TTABVUE 260-61, 101:9-102:24; *see also* 38 TTABVUE 329-334, 72:12-77:24.

⁸⁵ 28 TTABVUE 4, 6.

⁸⁶ 35 TTABVUE 270.

⁸⁷ *Id.*

- Respondent will conduct a reasonable search of documents in its possession, custody and control, for non-privileged correspondence with the stated dictionary and will produce any responsive non-privileged documents within a reasonable time on a rolling basis.⁸⁸
21. Respondent produced the 13 dictionary letters on July 14, 2022,⁸⁹ after the parties' meet and confer on June 15, 2022.⁹⁰ Additional documents (emails showing that Respondent's outside counsel was served with the dictionary letters) were served on Petitioners on January 18, 2023.⁹¹
22. Respondent did not inform its own expert witness, Dr. Finegan, about its efforts to effect changes to dictionary definitions of "Lego" prior to the preparation of his expert report;⁹² rather, Respondent told Dr. Finegan about the letters to the dictionary publishers about two to three weeks prior to his second deposition conducted on October 27, 2022.⁹³
23. During Dr. Finegan's second discovery deposition on October 27 2022, he stated that although he would have put the evidence related to the *MacMillan Dictionary* in a different bucket as a result of the change in evidence,⁹⁴ Dr. Finegan stated that he would not change the ultimate opinion he gave in his expert report.⁹⁵
24. Respondent's counsel, Melanie Raubeson, testified at her deposition on December 15, 2022, that she knew that the letters could cause the dictionaries to change or remove their definitions of "lego."⁹⁶
25. Respondent filed a motion for protective order in the U.S. District Court of Connecticut to terminate the deposition of Ms. Raubeson on December 22,

⁸⁸ *Id.* at 299-301.

⁸⁹ 35 TTABVUE 11; Brunau dec., ¶ 23, 38 TTABVUE 8, 29.

⁹⁰ 38 TTABVUE 7, 33-34, Brunau dec., ¶¶ 18, 23.

⁹¹ 37 TTABVUE 2.

⁹² 35 TTABVUE 12, 314-316, second deposition of Dr. Finegan, at 7:12-19, 10:6-13 and 18:22-19:7.

⁹³ *Id.* at 314.

⁹⁴ *Id.* at 331, 162:13-23.

⁹⁵ *Id.* at 325, 145:13-25.

⁹⁶ *Id.* at 78, 40:17-41:2, deposition of Melanie Raubeson, Esq.

2022.⁹⁷ During preparation of its motion, Ms. Raubeson performed an additional search and discovered a two-page attachment from Oxford University Press dated February 28, 2021, and five other emails exchanged with three dictionaries, and attached those documents to her declaration in support of that motion.⁹⁸

26. The definitions that “changed” include the online definitions in Cambridge Dictionary, Collins Dictionary, Dictionary.com, MacMillan Dictionary, The Free Dictionary, YourDictionary.com, and Vocabulary.com.⁹⁹ Respondent states that prior versions of vocabulary.com cannot be retrieved via the Internet Archives, but the previous definition, as reproduced in the LEGO Group’s January 5, 2021 letter, clearly indicates the definition contained a “trademark” label. Ex. 3 at LEGO_TTAB_0024455 (“The website defines the LEGO trademark as “(trademark) a children’s plastic construction set . . .”).¹⁰⁰

27. Respondent states that it reviewed 40,188 documents in this proceeding.¹⁰¹ Respondent’s focus on responding to Petitioners’ discovery requests related primarily to search of electronically-stored information (ESI), in particular, non-privileged emails.¹⁰²

⁹⁷ 38 TTABVUE 10, 370; see *LEGO Juris A/S v. ZURU Inc. and ZURU LLC*, pending in the United States District Court, District of Connecticut. No. 3:22-mc-00102 (SVN). The Board takes judicial notice that as of July 24, 2023, an order has not yet issued on Respondent’s motion for a protective order. See Fed. R. Evid. 201(b)(2) (“The court may judicially notice a fact that is not subject to reasonable dispute because it ... can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.”); see also *United States v. Garcia*, 855 F.3d 615, 621 (4th Cir. 2017) (taking judicial notice of facts on U.S. federal agency website because it is a governmental source whose accuracy cannot be questioned), *overruled on other grounds*; *Diodato v. Mentor Worldwide LLC.*, No. JKB-20-762, 2020 WL 3402296, at *1 n.1 (D. Md. June 19, 2020) (taking judicial notice of FDA documents).

⁹⁸ 38 TTABVUE 10-11; Brunau dec. ¶ 6.

⁹⁹ *Id.* at 664-667.

¹⁰⁰ *Id.* at 12, n.10.

¹⁰¹ *Id.* at 5, 16, Brunau dec. ¶ 11, *id.* at 33.

¹⁰² “[Manually collected documents in addition to the dictionary letters] were not reviewed because the LEGO Group was focused on reviewing and coding more than 30,000 emails and electronic documents obtained from the 9 custodians in response to Zuru’s First Set of Requests for Production, and responding to Zuru’s improper and premature motion to compel.” *Id.* at 16, Brunau Decl. ¶ 11, *id.* at 32.

(iv) Order on Motion for Adverse Inferences for Discovery Fraud

In considering whether Respondent's discovery responses amount to "discovery fraud," the Board has considered whether Respondent failed to timely disclose or supplement its discovery production with its 13 letters to the dictionary publishers, as Petitioners argue, and whether Respondent mislead Petitioners that Respondent had already produced all documents relating to Respondent's efforts to prevent generic use or misuse of "Lego." In particular, the Board has focused on Respondent's responses to Petitioners' most relevant discovery requests, i.e., Requests for Production Nos. 4 and 11, as well as Respondent's other conduct related to responding to Petitioners' discovery requests, set forth, *supra*, in the Board's factual findings.

After full consideration of the parties' submissions, the Board finds that Respondent's initial responses to Petitioners' discovery requests, namely, that it was not withholding responsive documents or information, was based on a reasonable construction of Petitioners' first set of discovery requests. Although it is *arguable* that Respondent's 13 dictionary letters were responsive to Petitioners' Request for Production Nos. 4 and 11, Respondent did not have the benefit of a Board ruling on the scope or meaning of the requests. *Cf. Univ. of Notre Dame du Lac v. J.C. Gourmet*, 217 USPQ at 510 n.11 ("The witness did not 'refuse' to answer in the technical sense for which sanctions may be imposed. ... The expression 'failure' or 'refusal' to answer is more appropriately used where there is no response following a ruling by the board

or a court that the objection was not valid.”). Additionally, Respondent’s supporting documents show that its late disclosure was unintentional.¹⁰³

“[F]raud upon the court is ‘typically confined to the most egregious cases ... in which the integrity of the court and its ability to function impartially is directly impinged.’” *Optimal Chem.*, 2019 USPQ2d 338409, at *8 (citing *Broyhill Furniture Indus., Inc. v. Craftmaster Furniture Corp.*, 12 F.3d 1080, 29 USPQ2d 1283, 1287 (Fed. Cir. 1993)). Even though Respondent did not disclose the dictionary letters and related evidence until later in this proceeding, which clearly delayed this proceeding to the extent that Petitioners conducted a second deposition of Dr. Finegan, the Board finds no basis for drawing the adverse inferences Petitioners seek.¹⁰⁴ Such a ruling would not be proportionate to Respondent’s conduct detailed above insofar as it would directly affect the Board’s determination of the merits of Petitioners’ claim at trial. *See Busy Beauty*, 2019 USPQ2d at *6 (“A court may order measures no greater than necessary to cure any prejudice only “upon finding prejudice to another party from the loss of information.”) (citing Fed. R. Civ. P. 37(e)(1)); *see also Trigon Ins.*, 204

¹⁰³ Respondent’s counsel explained that 108 manually-collected documents, including the dictionary letters, were inadvertently “segmented” from the ongoing review of 30,000 emails documents, therefore they were not reviewed or coded for production in 2021 and they were not produced in 2021. 38 TTABVUE 5, Brunau dec., ¶¶ 10-11, *id.* at 31-32; *see also* 38 TTABVUE 30; Brunau dec., ¶ 5 (regarding dictionary letters), *id.* at 107-132. The team member at Day Pitney conferring with Dr. Finegan was not involved with the dictionary letters, and was also not involved with the LEGO Group’s document collection, review and production, creating information asymmetry between team members. 38 TTABVUE 5; Brunau Decl. ¶ 16, *id.* at 32; *see also* 35 TTABVUE 215, 218 and 219 and 19 TTABVUE 118.

¹⁰⁴ Specifically, that the 13 dictionary definitions provide evidence of the genericism of the “lego” mark, that “dictionary evidence” in general is unfavorable to Respondent, that dictionary evidence supports a finding of genericism, and that “lego” has become generic.

F.R.D. at 286 (“The degree of culpability and the prejudice suffered by the moving party will guide a Court in its formulation of remedial and punitive action.”).

Although Respondent did not disclose the evidence of its letter-writing campaign for over one year, delayed disclosure, as in this case, is not equivalent to actively misleading the adverse party as to the non-existence of documents, destroying evidence, making a false representation to the Board, or submitting a false document to the Board, which are generally the types of conduct involved when the Board has made adverse inferences as a sanction. *See, e.g., Optimal Chem.*, 2019 USPQ2d 338409, at *8 (“If a party is found to have manufactured evidence by fabrication or alteration of preexisting evidence, or to have intentionally provided false testimony in a deposition or at trial, dismissal of that party’s claims or defenses can be the proper sanction as an exercise of the Board’s inherent authority to protect the integrity of the judicial process.”); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons*, 55 USPQ2d 1298, 1303 (TTAB 2000) (“where the record contains suspicious documents, and where answers given under oath seem disingenuous and are intentionally vague or unclear, we must necessarily draw inferences adverse to respondent”); *Doctor Vinyl*, 220 USPQ at 645 (in view of “the falsity of the testimony and documents offered by [applicant’s witness], we treat the balance of [the witness’s] testimony ... as having no credibility whatsoever, [and] ... give no weight to the only other documentary exhibits offered [the same witness] during his discovery deposition ...”).¹⁰⁵

¹⁰⁵ “The allegedly fabricated documents and the representations concerning them in sworn testimony were directed to proving prior and continuous use of applicant’s mark DOCTOR

Further, even though Petitioners' second deposition of Dr. Finegan could have been avoided had Respondent promptly informed him of its policing efforts vis-à-vis dictionaries, the Board agrees with Respondent that Petitioners were not prejudiced.¹⁰⁶ "An evaluation of prejudice from the loss of information necessarily includes an evaluation of the information's importance in the litigation." *Busy Beauty*, 2019 USPQ2d 338392, at *6. Critically, Dr. Finegan stated in his second discovery deposition that his ultimate opinion did not change even after learning of Respondent's letter-writing campaign.

Additionally, dictionary evidence is only one source of information for the Board to consider in determining whether the purchasing public views the term at issue to be generic for the involved goods or services. *See, e.g., Loglan Inst. Inc. v. Logical Language Grp. Inc.*, 902 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) ("Evidence of what the relevant public understands the term to mean may come from direct consumer testimony, surveys, dictionary listings, newspapers, and other publications."); *see also Dan Robbins & Assocs, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013) (purchaser testimony, consumer surveys, trade journals, newspapers and other publications are also relevant), *aff'd*

VINYL and since priority is the only contested issue in this opposition, there is no question that consideration of the fraud issue is essential to our determination of the proceeding on its merits."

¹⁰⁶ 38 TTABVUE 20.

mem., 565 F. App'x 900 (Fed. Cir. 2014). Accordingly, other than having to conduct a second deposition of Dr. Finegan, the Board finds no prejudice to Petitioners resulting from Respondent's delay in disclosing its letter-writing campaign until Petitioners posed more exact discovery questions.

In any event, even if Respondent had been successful in hiding its letter-writing campaign to dictionary publishers, the lack of dictionary evidence regarding a particular term is not dispositive of the issue of genericness.¹⁰⁷ *See, e.g., Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) ("Although there is no dictionary listing for the term "e-ticket" per se, this fact is not dispositive of the issue. No dictionary is complete or completely up to date, or tracks the language of the marketplace perfectly. A number of generic terms are not found in dictionaries.") (internal citation omitted). "Whether a term is generic is determined by actual common usage." *In re Deutsche Airbus GmbH*, 224 USPQ 611, 614 n.12 (TTAB 1984). Furthermore, at trial, the Board will consider the entirety of the record to determine whether Petitioners have made a showing based on clear evidence of generic use. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4

¹⁰⁷ Moreover, if Petitioners had not discovered Respondent's letter-writing campaign, and if Respondent sought to submit such evidence at trial, such evidence that would have been responsive to Petitioners' discovery requests would be subject to a motion to strike. *See, e.g., Panda Travel*, 94 USPQ2d at 1792-93 (documents not produced until after the start of trial stricken); *Nat'l Aeronautics and Space Admin. v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration); *see also* TBMP § 527.01(e); *cf. Sheetz of Delaware, Inc. v. Doctor's Assoc. Inc.*, 108 USPQ2d 1341, 1346 (TTAB 2013) (applying "Great Seats factors," opposer's failure to supplement its discovery responses or initial disclosures with respect to third-party use found harmless).

USPQ2d 1141, 1143 (Fed. Cir. 1997); *Alcatraz*, 107 USPQ2d at 1763; *Continental Airlines*, 53 USPQ2d at 1396-97.

Finally, the parties' submissions show that, with the exception of a small number of documents served on January 18, 2023,¹⁰⁸ Respondent effectively cured the allegedly late disclosure by: (1) supplementing its production of documents in response to Petitioners' Requests for Production of Documents, albeit late in the discovery period, (2) informing its expert witness, Dr. Finegan, of its dictionary letter-writing campaign, and (3) permitting Petitioners to depose Dr. Finegan again.

In view of the foregoing, the Board finds no prejudice to Petitioners as regards the evidence of the dictionary letters that would justify making adverse inferences against Respondent. *Cf. Residential Funding Corp. v. DeGeorge Fin. Corp.*, 306 F.3d 99, 112-113 (2d Cir. 2002) (different "from the typical spoliation case because the evidence at issue was apparently not destroyed, but merely not timely produced [until after trial]," remanded to the district court to consider, inter alia, "the likelihood that the newly produced e-mails would have affected the jury's verdict, in light of all of the other evidence adduced at trial" and directing the district court to separately consider whether plaintiff's actions of "purposeful sluggishness" in discovery warrant imposition of sanctions¹⁰⁹); *see also Seligman & Latz*, 222 USPQ at 723 (While we believe that applicant's answers cast doubt on the probative value of these discovery

¹⁰⁸ 37 TTABVUE 2.

¹⁰⁹ "District courts should not countenance 'purposeful sluggishness' in discovery on the part of parties or attorneys and should be prepared to impose sanctions when they encounter it." *Residential Funding*, 306 F.3d at 113.

responses, we decline to make the presumption requested because this sanction is best left to situations where a witness fails or refuses to answer a question asked during a *testimony* deposition, or at least one asked during discovery where the witness fails or refuses to comply with an order of the Board or a court compelling the witness to answer the question.) (emphasis original).

Accordingly, to the extent Petitioners seek adverse inferences based on discovery fraud, said motion for sanctions is **DENIED**.

2. Motion to Exclude Expert Evidence

To the extent Petitioners request that the Board prospectively exclude Respondent's expert evidence, said motion is **DENIED**. It is not the Board's practice to make prospective or hypothetical evidentiary rulings before trial. *See Greenhouse Sys. Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995); *see also Hunter Indus. Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (as Board does not entertain motions in limine, opposer was unable to raise the matter by motion until applicant submitted declarations during its testimony period); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) ("Board does not make prospective or hypothetical evidentiary rulings."); *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942 (TTAB 2013) (Board does not entertain motions in limine or otherwise exclude evidence prospectively); TBMP § 527.01(f).

C. Petitioners' Motion to Compel Additional Depositions

Petitioners also request that the Board compel Respondent to: (1) produce any additional documents related to its letter-writing campaign, “including documents that would otherwise be subject to the attorney-client privilege because, as a matter of law, [Respondent’s] conduct meets the standard for the crime-fraud exception to the privilege;” and (2) reproduce for a third time Respondent’s dictionary expert and its in-house counsel who authored the letters for further depositions at which [Respondent] should be precluded from asserting privilege over communications related to the letters.”¹¹⁰ In particular, Petitioners seek an order requiring Respondent to produce Respondent’s counsel, Ms. Raubeson, and other witnesses for additional discovery depositions so that Petitioners can seek information relating to the timing of Respondent’s disclosure of the dictionary letters. With respect to Ms. Raubeson, Petitioners request that she be ordered to answer questions without asserting any objections based on privilege or work product.¹¹¹

In support of the motion to compel, Petitioners argue, in part, that Respondent sought to hide the evidence of its letter-writing campaign in order to avoid the Board concluding that Respondent’s relatively recent policing of its registered marks had little impact on consumer perception.¹¹² See *Int’l Dairy Foods Ass’n v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, *17-18

¹¹⁰ 35 TTABVUE 4.

¹¹¹ *Id.* at 25.

¹¹² *Id.* at 17.

(TTAB 2020) (“Without evidence, we are not persuaded that such a limited campaign could change consumer perception so quickly.”). Petitioners contend that additional discovery is necessary in order to flush out the timing and circumstances of Respondent’s creation and disclosure of the dictionary letters, including who was involved in the concealment of the letters and whether Respondent pursued “claims or remedies” against any dictionaries that did not cave to its requests.”¹¹³

As a threshold matter, the Board must determine whether Petitioners made a sufficient showing that they made a good faith effort to resolve the parties’ conflict prior to filing the alternative motion to compel. *See* Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1). Petitioners’ motion includes a “Certification of Meet and Confer” on the last page of the motion, which certifies that Petitioners had conferred with Respondent, including through email and a conference call, and that “The Lego Group agreed in that conference call that the parties are at an impasse on all issues contained herein.”¹¹⁴ Petitioners provide no specific information regarding their attempts to resolve the dispute that is the subject of the motion to compel.

As discussed in the Board’s prior order on Petitioners’ motion to compel,¹¹⁵ the Board expects that the movant’s showing of good faith will comprise a recitation of the communications conducted, including dates, a summary of telephone conversations, and copies of any correspondence exchanged, where applicable (e.g.,

¹¹³ 35 TTABVUE 5, 15.

¹¹⁴ *Id.* at 28.

¹¹⁵ 28 TTABVUE 4.

emails, letters, notes to file). *Hot Tamale Mama ... and More, LLC v. SF Inv., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see also* TBMP § 523.02 (in determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete). A mere certification of a good faith effort is insufficient.

Respondent's counsel, Ms. Alquist, states in her email of December 29, 2022 (six days prior to the filing date of the subject motion), "[t]he client is closed until January 3, but if we can obtain that information sooner than then we will do so. In any event, we will make the request and will provide an update next week. Thus, the motion to compel that you threaten multiple times below is moot, without factual basis, and would be filed in bad faith."¹¹⁶

There is no explanation in Petitioners' certification statement that explains why Petitioners did not wait until after Respondent reopened in January 2023, as requested by Respondent's counsel, to file the motion to compel. In view thereof, the Board cannot find that Petitioners made a good faith effort to resolve the subject matter of the motion to compel prior to filing same. *See* Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1).

In any event, the Board finds no basis in the record for allowing Petitioners to take another discovery deposition of Respondent's counsel regarding Respondent's

¹¹⁶ 38 TTABVUE 630.

disclosure of its letter-writing campaign, much less deposing Dr. Finegan for a third time. Accordingly, Petitioners are advised that the Board will not consider any future motion to compel the discovery deposition of Dr. Finegan or Respondent's counsel (whether in-house or outside counsel) regarding Respondent's letter-writing campaign to publishers of dictionaries.

Accordingly, in view of the foregoing, Petitioners' motion to compel is **DENIED with prejudice**. Respondent is allowed until **THIRTY DAYS** from the mailing date of this order¹¹⁷ to serve any supplementary non-privileged documents that are responsive to Petitioners' previously served discovery requests.

III. The Board Expects the Parties to Cooperate during Discovery

Although the Board has determined that Respondent's conduct during this proceeding constitutes neither spoliation of evidence nor "discovery fraud," the Board hastens to point out that Respondent was nonetheless not as cooperative as it could have been during the discovery period, which contributed to the delay in this proceeding. Specifically, as mentioned supra, even though Dr. Finegan, on March 2, 2022, opined during his first deposition that Respondent may have contacted the lexicographers at *The Cambridge Dictionary* with "a warning or something,"¹¹⁸ Respondent did not inform Petitioners of the dictionary letters until four months later, on July 14, 2022, when Respondent responded to Petitioners' more specific

¹¹⁷ This is a scheduling, not a compel order.

¹¹⁸ 35 TTABVUE 228, first deposition of Dr. Finegan, 140:4-24.

discovery requests.¹¹⁹ The discrepancy in the dictionary data could have been explained earlier in the proceeding, potentially to Petitioners' satisfaction. Further, it was clearly not necessary for Respondent to challenge Petitioners' rebuttal expert, Dr. Leonard, during his deposition, asserting that he had no direct evidence that Respondent "put pressure on a dictionary,"¹²⁰ when Respondent's counsel knew that it had indeed sent such letters. In short, these instances demonstrate both lack of communication and cooperation on Respondent's part during the discovery process.

Discovery responses, like initial disclosures, and pretrial disclosures, should be viewed as a continuum of *inter partes* communication designed to avoid unfair surprise and to facilitate fair adjudication of the case on the merits. *Spier Wines (PTY) Ltd. v. Shepherd*, 105 USPQ2d 1239, 1246 (TTAB 2012). Both parties are reminded that the Board looks with extreme disfavor on parties who do not cooperate with each other during the discovery process. *See e.g., Emilio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (parties have affirmative duty to cooperate in the discovery process); *Panda Travel*, 94 USPQ2d at 1791 ("The Board expects parties to cooperate during discovery. Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary."); *see generally* TBMP § 408.01.

¹¹⁹ 35 TTABVUE 11; Brunau dec., ¶ 23, 38 TTABVUE 8, 29.

¹²⁰ 35 TTABVUE 260-61, 101:9-102:24; *see also* 38 TTABVUE 329-334, 72:12-77:24.

IV. Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. In accordance with the parties' stipulation (filed November 9, 2022¹²¹) to modify the trial schedule, the discovery period is extended for the limited purposes set forth in the motion; and trial dates are reset as shown in the following schedule:

Discovery Closes	9/18/2023
Plaintiff's Pretrial Disclosures Due	11/2/2023
Plaintiff's 30-day Trial Period Ends	12/17/2023
Defendant's Pretrial Disclosures Due	1/1/2024
Defendant's 30-day Trial Period Ends	2/15/2024
Plaintiff's Rebuttal Disclosures Due	3/1/2024
Plaintiff's 15-day Rebuttal Period Ends	3/31/2024
Plaintiff's Opening Brief Due	5/30/2024
Defendant's Brief Due	6/29/2024
Plaintiff's Reply Brief Due	7/14/2024
Request for Oral Hearing (optional) Due	7/24/2024

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in

¹²¹ 33 TTABVUE.

Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121-2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).

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